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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,415	11/21/2000	Masaru Takeda	107904	8263

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

NGUYEN, HAI V

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 09/07/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,415

Applicant(s)

TAKEDA ET AL.

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the communication received on 26 May 2004.
2. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito et al. U.S. patent no. 6,587,219** in view of **Weschler U.S patent no. 6,470,332 B1**.

5. As to claim 1, Saito discloses an information output system comprising:

a managing section for managing a mail address for each output apparatus

(*Saito, Abstract, Fig. 3; col. 1, line 67 - col. 2, line 10*); However, Saito does not explicitly disclose searching an output apparatus group for one candidate output apparatus or a plurality of candidate output apparatuses in response to a search request from a terminal apparatus; Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing searching an output apparatus group for one candidate output apparatus or a plurality of candidate output apparatuses in response to a search request from a terminal apparatus.

In the same field of endeavor, Weschler, System, Method And Computer Product For Searching For, And Retrieving, Profile Attributes Based on Other Target Profile Attributes And Associated Profiles, discloses that *finding the resources in the distributed*

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system is to use directories. Directories are data structure that hold information such as mail address book information, printer locations, public infrastructure ("PKI") information, and the like... (Abstract, col. 5, lines 36-63; col. 4, lines 26-36; col. 9, line 30 – col. 10, line 16).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Weschler's teachings of searching resources by using directories (*Weschler, Abstract, col. 5, lines 37-64*) with the teachings of Saito, for the *purpose of allowing a user to initiate a search for, example, an individual without knowing exactly where he is located (Weschler, col. 5, lines 7-35).*

Saito-Weschler discloses notifying said terminal apparatus of the mail address of said candidate output apparatus (*Saito, Fig. 4; col. 3, line 45 – col. 4, line 7*); and

Saito-Weschler discloses distinguishing a designated output apparatus (*relay apparatus*) from said output apparatus group based on a destination mail address of an electronic mail issued from said terminal apparatus (*Saito, col. 3, line 45 – col. 4, line 7*),

Saito-Weschler discloses said designated output apparatus outputting information included in the electronic mail issued from said terminal apparatus (*Saito, col. 3, line 45 – col. 4, line 40*).

6. As to claim 2, Saito-Weschler discloses managing performance information for each of said output apparatuses, and said search section searches for said one candidate output apparatus or the plurality of candidate output apparatuses based on said performance information (*Saito, Fig. 3; col. 4, lines 8-18*).

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7. As to claim 3, Saito-Weschler discloses, wherein said managing section further manages installation position information for each of said output apparatuses, and said search section searches for said one candidate output apparatus or the plurality of candidate output apparatuses based on said installation position information (*Saito, Fig. 3, Tokyo, Osaka in column 1; col. 4, lines 8-18*).

8. Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito-Weschler** as applied to claims 1-3 above, and further in view of **Miyahara** U.S. patent no. **6,223,226 B1**.

9. As to claim 4, Saito-Weschler does not explicitly disclose an accounting processor for performing accounting processing before outputting the information included in said electronic mail. Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing the accounting processing before outputting the information included in said electronic mail.

In the same field of endeavor, Miyahara, Data Distribution System And Method For Distributing Data To a Destination Using A distribution Cost Associated Therewith, discloses that *the selector 4 selects using facsimile, whose cost is lowest among the available distribution means... When the distribution means is facsimile, the distribution data output apparatus 6 creates the facsimile data and distributes it to the destination facsimile number (Miyahara, col. 5, line 38 – col. 6, line 14)*.

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Miyahara's teachings of

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association of distribution cost corresponding to a destination (*Miyahara, Abstract, col. 5, lines 38 – col. 6, line 14*) with the teachings of Saito-Weschler for the *purpose of the selection of suitable distribution cost if the destination have a plurality of distribution means* (*Miyahara, col. 1, lines 51-56*).

10. Claim 5 recites similar limitations as claim 1 except for the limitation of “converting information included in said electronic mail in accordance with said designated printer” which is taught in Saito “*Internet facsimile apparatus 2 functioning as a relay apparatus converts a specific predetermined information among the header information of the email to be relayed transferred into the same data format as that of the image information* (*Saito, Abstract, Fig. 5A; col. 4, lines 7-59*)”.

11. Claim 6 is similar to the limitations of claims 2, 3; therefore, it is rejected under the same rationale as in claims 2, 3.

12. As to claim 7, Saito-Weschler-Miyahara discloses wherein the electronic mail is utilized to perform communication between said client and said first server (*Saito, Abstract, col. 1, line 55 – col. 2, line 6*).

13. As to claim 8, Saito-Weschler-Miyahara discloses, further comprising an authentication apparatus for performing user authentication prior to print processing of said converted information in said designated printer (*Weschler, PKI information, col. 6, lines 26-36*).

14. As to claim 9, Saito-Weschler-Miyahara discloses separating said electronic mail into a plurality of mail elements; and an individual managing section for individually

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managing said respective separated mail elements, and said information to be printed corresponds to one mail element (*Saito, Fig. 5A, Facsimile Image*).

15. As to claim 10, Saito-Weschler-Miyahara discloses a storing section in which the information constituting said electronic mail is stored; a monitor section for monitoring an empty capacity of said storing section; and a restricting section for restricting reception of a print request in accordance with lack of capacity of said storing section (*Saito, Fig. 3, col. 3, line 66 – col. 4, line 25*).

16. As to claim 11, Saito-Weschler-Miyahara discloses notifying said client of reception restriction when the reception of said print request is restricted (*Saito, Fig. 3, col. 3, line 66 – col. 4, line 25*).

17. Claims 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito-Weschler-Miyahara as applied to claims 1-11 above, and further in view of the well-known feature of conversion of PDL file.

18. As to claim 12, Saito-Weschler-Miyahara does not explicitly disclose converting the information included in said electronic mail to a PDL file in accordance with said designated printer.

The Examiner **takes Official Notice (see MPEP 2144.03)** that it is well known in the networking art to utilize PDL for converting and execution of the method and system in order to provide the outputting. Therefore, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have included the use of PDL file to convert and execute the information in the electronic mail of providing the outputting because use of PDL for programs used in general printing purpose computer

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to execute special purpose functions was routine in the art (*see Chapman et al. patent #: 6,522,421 B2; col. 1, line 60 col. 2, line 50*).

19. Claim 13 is similar limitation of claim 12; therefore, it is rejected under the same rationale as in claim 12.

20. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito-Weschler-Miyahara-the well-known PDL as applied to claims 1-13 above, and further in view of the well-known feature of checking virus in the electronic mail.

21. As to claim 14, Saito-Weschler-Miyahara does not explicitly disclose executing a virus check with respect to said electronic mail.

The Examiner **takes Official Notice (see MPEP 2144.03)** that it is well known in the networking art to utilize virus checking software for checking and execution of the method and system in order to provide the outputting. Therefore, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have included the virus checking program used in electronic mail because the virus checking programs is just the matter of design choices (*see Chen et al., patent # 5,832,208; col. 5, line 2 – col. 2, line 4*).

22. Claims 15-16 are similar limitations of claim 14; therefore, it is rejected under the same rationale as in claim 14.

23. Claim 17 is similar limitations of claims 1,4; therefore, it is rejected under the same rationale as in claims 1, 4.

24. Claim 18 is similar limitations of claim 4; therefore, it is rejected under the same rationale as in claim 4.

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25. Claim 19 is corresponding method claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

26. Claim 20 is corresponding computer readable medium of claim 1; therefore, it is rejected under the same rationale as in claim 1.

27. Claim 21 is similar limitations of claim 1; it is rejected under the same rationale as in claim 1.

Response to Arguments

28. Applicant's arguments filed on 26 May 2004 have been fully considered but they are not deemed to be persuasive.

29. In the remarks, Applicant argued in substance that:

Point (A), Applicant argued that there is no motivation or suggestion to combine the prior art.

As to point (A), In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Miyahara's teachings of association of distribution cost corresponding to a destination (*Miyahara, Abstract, col.*

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5, lines 38 – col. 6, line 14) with the teachings of Saito-Weschler for the *purpose of the selection of suitable distribution cost if the destination have a plurality of distribution means (Miyahara, col. 1, lines 51-56)*. Saito also suggests that *since the communication cost by email is inexpensive, the communication cost can be reduced by using Internet facsimile apparatus 13 locating distance to facsimile apparatus 12 as a relay apparatus (Saito, col. 1, lines 44-47)*.

Point (B), Applicant argued that “such reasoning is solely improperly hindsight based.”

As to point (B), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Point (C), The prior art does not disclose “searching an output group/printer for one candidate or a plurality of candidates in response to a search request” in claims 1, 5, 17, 19, 20, and 21.

As to point (C), Weschler discloses that *a method and a computer product for searching directories in a computer system ...determining candidate ones of the directories comprising matches to a first of sequence of query strings, iteratively applying remaining ones of the directories and returning a result set of data representative of the candidate ones of said directories having matched each of the specified sequence of query strings (Abstract, col. 5, lines 36-63) and finding the resources in the distributed system is to use directories. Directories are data structure that hold information such as mail address book information, printer locations, public infrastructure (“PKI”) information, and the like... (Abstract, col. 5, lines 36-63; col. 4, lines 26-36; col. 9, line 30 – col. 10, line 16). Saito also suggests that server 3 searches the notified facsimile number of the final destination and returns an e-mail address, the reception capability indicative of processing capability for image information (col. 3, lines 54-60; col. 5, lines 10-15).*

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30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

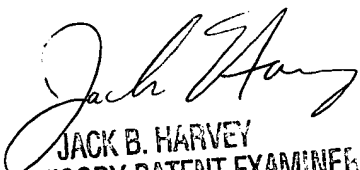
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 703-306-0276. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
Art Unit 2142



JACK B. HARVEY
SUPERVISORY PATENT EXAMINER